

REMARKS

Upon entry of the present amendment, claims 20 and 39 will have been amended by incorporating therein the recitations of claims 27 and 46 which will have been cancelled. The dependency of claims 28-30, 47-49, 64 and 65 will have revised in order to be consistent with the above-noted cancellation of claims 27 and 46.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection applied against the claims in the present application. Such action is respectfully requested and is now believed to appropriate and proper.

In the outstanding Official Action, the Examiner considered Applicant's arguments and withdrew the rejection of various claims under 35 U.S.C. § 102(e) as being anticipated by HUANG et al. Applicant notes the Examiner's withdrawal with appreciation.

In the outstanding Official Action, the Examiner rejected claims 20-31, 39-49, and 57-69 under 35 U.S.C. § 103(a) as being unpatentable over ENDO (U.S. Patent No. 6,801,340) in view of HUANG et al. (U.S. Patent Application Publication 2003/0097361). Applicant respectfully traverses the above rejection and submits that it is inappropriate.

Applicant's invention is directed to a communication apparatus that is connected to a terminal apparatus via a network. The communication apparatus includes a control panel that is configured to enter a destination address and a memory that stores an address book, including a plurality of destination addresses. The address book is stored as an HTML file and the communication apparatus further includes a transmitter that

transmits image data to a designated destination address which is stored in the address book. The image data is transmitted by at least one of the network and a telephone network, in response to an input from the control panel.

The communication apparatus further includes a communicator that transmits the address book to the terminal apparatus when a request for the address book is received from the terminal apparatus, and the address book is displayable at the terminal apparatus. A controller is provided that, in response to an instruction from the terminal apparatus, transmits at least one input screen associated with the address book to the terminal apparatus, the input screen having an input field enabling modification of the destination address and the input screen is configured so that the address book can be modified from the terminal apparatus.

The communicator transmits the address book and menu items to the terminal apparatus so that the address book and the menu items are displayed as a single image at the terminal apparatus, the menu items being utilized to change the content of the address book. The control panel, memory, transmitter, communicator and the controller are included within a self-contained unit.

It is respectfully submitted that the combination of features defining Applicant's invention as set forth in claim 20 and the generally related communication method as set forth in claim 39 are not taught, disclosed nor rendered obvious by the combination of references relied upon by the Examiner.

Turning to Applicant's disclosure, the address book is illustrated in FIG. 18. In particular, FIG. 18 shows a plurality of destination addresses of the address book. In response to actuation of any one of the menu items shown along the left-hand side of FIG. 18, an input screen, such as illustrated in FIGs. 19, 20 and 21 is transmitted to the terminal apparatus. Each of these input screens has an input field that enables modification of an address. Accordingly, the address book can be modified from the terminal apparatus by use of the input screens that are shown in FIGs. 19-21.

In other words, both the address book and menu items, as shown in FIG. 18, are displayed as a single image at the terminal and the menu items are utilized to change the content of the address book via one of the input screens shown in FIGs. 19-21. It is respectfully submitted that a communication apparatus having, *inter alia*, a memory in which an address book is stored, a communicator as recited, and a controller as recited, is not taught, disclosed nor rendered obvious by either of the references cited by the Examiner, nor by any proper combination of these references.

In setting forth the rejection, the Examiner asserts that the memory of ENDO discloses an address book that stores an HTML file and a controller that transmits at least one input screen associated with the address book. In this regard, the Examiner makes reference to column 10, lines 18-34, and FIG. 17. However, Applicant respectfully submits that while FIG. 17 does disclose an address book, the address book of ENDO does not include or disclose the input screen as recited in Applicant's claims. In this regard, Applicant notes that as described at column 10, lines 18-34, the address book editor

converts the contents of the abstract destination file 1501 and the detail destination file 1505 into HTML format data and displays the data via the web server 1403 on the browser which operates on the client PC 108 connected to the external device via the network. Thus, ENDO does not disclose an input screen having an input field enabling modification of a destination address such that the address can be modified from the terminal apparatus or menu items which are displayed with the address book as a single image at the terminal wherein the menu items are utilized to change the content of the address book. The address book editor 1402 merely converts the destination files into HTML format, a feature included in the address book of claim 20 ("the address book being stored in a HTML file"). Thus, ENDO does not disclose the claimed "modification" at all.

The Examiner further asserts that the input screen of ENDO has an input field enabling modification of the destination address and in this regard makes reference to FIGs. 17 and 18. Applicant respectfully submits that the Examiner is incorrect. In FIG. 17, it is not the address book screen that has the input field associated therewith but rather the individual destination screens (Minnie Mouse) shown at the bottom part of FIG. 17 and throughout FIG. 18. In particular, ENDO does not disclose, teach nor render obvious the interplay between the disclosed features of FIG. 18 and the appropriate one of FIGs. 19-21 as embodied in the claims pending herein. In other words, screens 1701 and 1703 do not provide input fields and single image as recited. Screen 1706 which does disclose various menu items, merely shows a detail of an individual one of the destinations, but does not illustrate the address book and menu items as a single image.

While HUANG et al. does provide a virtual desktop such that various operations can be conducted from various individual terminals, HUANG et al. also does not disclose the interplay between the at least one input screen with an input field that enables modification of a destination address and where the address book and menu items are transmitted and are displayed as a single image at the terminal such that the menu items can be utilized to change a content of the address book. In other words, and as noted above with respect to ENDO, HUANG et al. does not teach nor render obvious the interplay between the disclosed features of FIG. 18 and the selected one of FIGs. 19-21 as embodied in, e.g., Applicant's claim 20.

Accordingly, for each of the above reasons, it is respectfully submitted that Applicant's claims are clearly patentable over the combination of ENDO and HUANG et al.

Yet additionally, Applicant respectfully submits that there is no proper basis for the combination of ENDO and HUANG et al. In this regard, Applicant notes that the mere fact that both of these references are from the "same field of endeavor" does not, in and of itself, provide an adequate basis for the combination of the disclosures, as proposed by the Examiner. In fact, the Examiner's basis for motivation is nothing more than the ultimate conclusion, and is inadequate since the Examiner has set forth no evidence in support thereof. Quite the contrary, Applicant submits that there is no proper motivation for combining the teachings of these two references. In this regard, Applicant notes that ENDO is related to a unidirectional document transfer apparatus and method. ENDO's stated goal is to enable transmitting data to a plurality of destinations using different

transmission methods. As such, there is no need whatsoever for bi-directional communication in ENDO. On the other hand, HUANG et al. deals with distributed computing and a distributed or decentralized message center.

While there are certainly features in common between ENDO and HUANG et al., the Examiner has not set forth and Applicant submits that there is no motivation for combining the selected features of these references. In particular, ENDO is directed to a data communication apparatus and method that does not require the two directional communication of HUANG et al. For this additional reason, it is respectfully submitted that Applicant's claims are clearly patentable over the combination of HUANG et al. and ENDO. An action to such effect is respectfully requested in due course.

Applicant notes that the various dependent claims are patentable based on their dependence from a shown to be allowable independent claim as well as based upon their own particular recitations. In this regard and as an example only, Applicant notes the recitations of claims 64 and 65 which are also not disclosed by the Examiner's proposed combination.

In particular, neither ENDO nor HUANG et al., nor any proper combination of these references discloses that the single image that displays the address book and the menu items is configured such that selection of one of the menu items at the terminal causes the communication apparatus to transmit a related one of a plurality of images to a terminal, wherein each of the plurality of images is configured to permit one of an addition to the address book, a deletion from the address book and an editing of the address book.

These features, which are defined in the disclosure with respect to FIGs. 18-21 are not disclosed by the references cited by the Examiner. In regard to claims 64 and 65, Applicant notes the Examiner's reference to FIGs. 17-20. However, as noted above, those screens of FIGs. 17-20 that disclose addition, deletion or editing are details of a single entry of the address book. Thus, ENDO does not disclose a single image displaying the address book and the menu items as recited in Applicant's claims 20 and 39 and further detailed in claims 64 and 65.

Accordingly, these dependent claims as well as the other dependent claims have yet additional bases for the patentability thereof based on their particular recitations.

Applicant notes that the status of the present application is after Final Rejection but submits that entry of the present amendment is appropriate and proper. In this regard, Applicant notes that he has merely incorporated the features of canceled claims 27 and 46 into independent claims 20 and 39 and changed dependency accordingly. Thus, no new issues are raised by these amendments.

Accordingly, Applicant respectfully requests entry of the present amendment, reconsideration of the outstanding rejection and an indication of the allowability of all of the claims pending herein.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the claims by incorporating the features of a dependent claim into each of the independent claims. Applicant has further discussed the disclosures of the references relied upon by the Examiner and has pointed out the significant and substantial shortcomings and deficiencies of the references with respect to the combination of features recited in Applicant's claims, both with respect to the references individually as well as with respect to the combination of references. Additionally, Applicant has set forth the lack of a proper motivation for the Examiner's proposed combination. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Applicant has further set forth a basis for the entry of the present amendment, although the status of the application is after Final Rejection.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

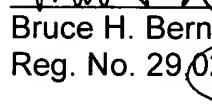
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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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